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OFFICE OF PETITIONS

In re Application of :
Lencki et al. : DECISION ON
Application No. 09/748,359 : PETITION
Filed: December 26, 2000 :
Atty Docket No. CLC 00.20 :

This is a decision on the PETITION FOR SUSPENSION OF THE RULES UNDER 37 C.F.R. §1.183 filed April 9, 2008. This decision is made in light of the 3.73(b) statement filed April 30, 2008.

The petition under 37 CFR 1.183 is GRANTED to the extent indicated herein. This is not a decision on the merits of the 1.131 declaration.

The above-identified application was filed on December 26, 2000. A 37 CFR 1.63 declaration signed by all of the inventors (Lencki, Henchey and Miller) was filed on December 26, 2000. On April 9, 2008, applicant filed under seal an inventor's declaration under rule 131. Applicant states that the 1.131 declaration is signed by David Gordon on behalf of the assignee of record.

Applicant has filed the instant petition to have the 37 CFR 1.131 declaration accepted without the signature of the inventors. Applicant requests waiver of the requirement that all of the inventors sign the declaration. In support thereof, applicant submits copies of the letter transmitting the 1.131 declaration to the inventors.

37 CFR 1.131 states, in pertinent part:

When any claim of an application or a patent under reexamination is rejected, the inventor of the subject

matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.

In addition, the Manual of Patent Examining Procedure states that "an application or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection."

Here, there has not been a party qualified under 37 CFR 1.42, 1.43, or 1.47. In addition, applicant does not contend that less than all of the named inventors of the application invented the subject matter of the claims under rejection. Accordingly, the proper parties to sign the 37 CFR 1.131 declaration include all of the joint inventors.

In order for a petition under 37 CFR 1.183 to be granted to waive the requirement that all of the joint inventors sign the 1.131 declaration, petitioner must demonstrate that this is an extraordinary situation where justice requires waiver of the rules.

On instant petition, applicant has set forth the steps taken to obtain the signatures of the three inventors on the 1.131 declaration. Applicant has submitted adequate proof that the 1.131 declaration was presented by letter dated April 8, 2008 to each of the inventors and that the inventors have not responded to the request to sign the declaration. There is no evidence of record indicating that any of the mailings to inventors was returned as undeliverable.¹ Accordingly, refusal to sign the declarations is inferred from the failure to respond. Applicant has provided a 1.131 declaration signed¹ by David Gordon on behalf of the assignee along with a 3.73(b) statement establishing his authority to act on behalf of Choicelinx

¹ The declaration under 1.131 was submitted under seal. In reaching this favorable decision, it was necessary for the undersigned to know the precise contents of the declaration. The undersigned is relying on applicant's assertion that the 1.131 declaration was signed by David Gordon on behalf of the assignee. If the examiner determines upon review on the merits that the 1.131 declaration was not signed by David Gordon, then this matter should be returned to the undersigned for reconsideration.

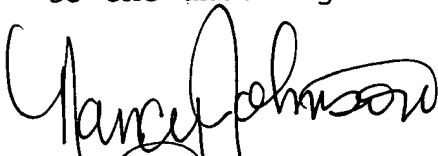
Corporation as assignee. An assignment of this application to Choicelinx Corporation executed by all three inventors is of record in the Office. Under the circumstances, it is concluded that petitioner has demonstrated that this is an extraordinary situation, warranting waiver of the rules.

The petition is granted to the extent that the 37 CFR 1.131 declaration may be entered, despite the fact that its requirement that all of the inventors sign the declaration has not been satisfied. This is not a decision on the merits of the declaration or on any other evidence presented.

The \$400 (not \$130) fee required for consideration of this petition under § 1.183 has been charged to Deposit Account No. 50-0310, as authorized.

Technology Center AU 3626 has been advised of this decision. The application is, thereby, forwarded to the Technology Center for further action by the examiner in light of this decision granting waiver of the requirement that all of the inventors sign the 1.131 declaration.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a large, stylized initial "N" and "J".

Nancy Johnson
Senior Petitions Attorney
Office of Petitions